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21 UNITED STATES DISTRICT COURT
22 NORTHERN DISTRICT OF CALIFORNIA
23 SAN FRANCISCO DIVISION

24 ORACLE AMERICA, INC.

25 Plaintiff,

26 v.

27 GOOGLE INC.

28 Defendant.

Case No. CV 10-03561 WHA

**ORACLE'S RESPONSE TO COURT'S
REQUEST (ECF NO. 1880) FOR
BRIEFING RE WILLFULNESS AND BAD
FAITH BEFORE FEDERAL CIRCUIT
DECISION**

Dept.: Courtroom 8, 19th Floor
Judge: Honorable William Alsup

INTRODUCTION

Oracle respectfully submits that the jury may not and should not consider the Court’s copyrightability decision—nor any other “law in the case” prior to the Federal Circuit’s 2014 decision or after—to evaluate Google’s willfulness or bad faith.¹ *First*, Google did not disclose the Court’s 2012 copyrightability decision or any other “law in the case” as a basis for its fair use and damages contentions. Throughout this case, Google never argued or identified any evidence or testimony—expert or percipient—showing that Google relied on the Court’s 2012 decision or any other “law in the case” when it decided whether to copy. Nor could it: Google explicitly disclaimed any advice of counsel defense, and the parties agreed that the jury should not hear about this case’s procedural history, whether from the Court or the parties. Even if Google could offer such evidence, it would need to *prove* reliance on the Court’s decision. It is implausible that Google’s top business executives simply read this Court’s decision and decided on a course of action without consulting its attorneys (in-house or outside counsel). Accordingly, to prove reliance, Google must offer the communications from its lawyers about this Court’s decision as well as otherwise privileged analyses of Google’s chances of winning on appeal, before the Supreme Court, and again on remand, all to assess whether Google really did rely on the Court’s decision. Google has offered no such evidence and instead has maintained privilege over all attorney communications.

Second, such information is irrelevant. The standard for willfulness and bad faith in copyright law is *subjective*. By contrast, evidence of the state of the law regarding copyrightability at most may be relevant to whether an infringer’s actions were *objectively* reasonable, which is irrelevant to willfulness and bad faith. Moreover, Oracle has not found a single case where a court on remand has instructed the jury as to prior procedural history for purposes of determining willfulness or bad faith—even in cases with procedural postures similar to this one. Instead, numerous courts in copyright and patent cases have found willfulness on remand after initial decisions for the defendant were reversed. Further, throughout this case, both parties have

¹ ECF No. 1880 (“An issue for us in this follow-on trial is whether and to what extent the jury may consider the *law in the case* prior to the 2014 holding by the Federal Circuit in evaluating willfulness and bad faith by Google during that period.”) (emphasis added).

consistently represented—with full knowledge of the Court’s 2012 decision, the Federal Circuit’s 2014 decision, and the repeated releases of new versions of Android—that there is no theory that justifies breaking up the case into different time periods.

Third, even if the Court’s 2012 decision or any other “law in the case” were relevant to Google’s willfulness and bad faith, the issue would be one for the Court to decide, not the jury. The jury is not qualified to determine the state of the law. Oracle has not found any case where a court instructed the jury in the manner this Court has proposed here. To do so would invite a mistrial and would cause the jury to sit as judges on the state of the law at all relevant times over the past 10 years, even though the state of the law is not within the province or expertise of the jury. Indeed, even where legal issues are relevant to willfulness (such as in patent cases), the legal component is always decided by the court, not the jury.

In short, such an instruction is irrelevant, unnecessary, and prejudicial, as it would taint the jury and effectively direct a verdict that Google’s copying was reasonable given the supposed uncertainty in the law, and thus “fair.” Oracle is mindful, however, that the Court has expressed concerns about potential jury confusion and suggested that there are “ways even now for Oracle to agree to scale back its arguments and to cure this problem,” so the Court need not “give an instruction” to the jury. Trial Tr. 935:22-936:4. Oracle is therefore willing to stand on only evidence of pre-May 2012 conduct by Google in order for Oracle to show willfulness.

I. GOOGLE NEVER DISCLOSED ANY PRE-2014 “LAW IN THE CASE” AS A BASIS FOR ITS FAIR USE AND DAMAGES CONTENTIONS, NOR CLAIMED IT RELIED ON THIS COURT’S 2012 DECISION

Lack of disclosure. Google did not disclose the Court’s 2012 copyrightability decision nor any other “law in the case” as a basis for its fair use and damages contentions. Specifically, Google did not mention the Court’s 2012 decision or any other “law in the case” in response to Oracle’s interrogatory requesting the bases for any fair use contention. Google’s First Suppl. Resp. and Obj. to Oracle’s Interrogs., Set 6, No. 40 at 9-15. Further, Google has not once identified any evidence, argument, or testimony that shows that it relied on the Court’s 2012 decision or any other “law in the case.” No expert has opined on the temporal demarcations bounding when Google could, and could not have been, willful. Even assuming such defenses

1 were cognizable and that Google was free to pursue them upon remand, Google declined to do so
2 and cannot undo that strategic decision now in the middle of trial.

3 To the contrary, Google *agreed with Oracle* that the Court *should not* inform the jury
4 about the prior trial or appeal: “The parties agree that the Court need not and should not inform
5 the jury regarding the procedural history of the case.... The Court should not reference the prior
6 trial or appeal.” ECF No. 1709 at 7.² As this was an agreement by both parties, the Court should
7 not undo the agreement without the assent of both parties. That Google is the only party willing
8 to undo the agreement is a red flag that Oracle would be substantially prejudiced by an instruction
9 along the lines that the Court is contemplating. *See* ECF No. 1874 (Oracle Br. re: Instruction on
10 Proc. History) at 1-6. No jury is likely to return anything but a defense verdict on a question like
11 fair use after it learns that *any* trial judge, let alone the presiding one, thought the declaring code
12 and SSO were not copyright protected and that a previous jury could not reach a result on fair use.

13 If Google wanted to put on witnesses to testify that Google performed a legal analysis—
14 before or after the Court’s 2012 decision—and concluded that the declaring code and SSO were
15 not copyrightable or that it was an open question, then that is a strategy Google could have
16 pursued. Instead, Google explicitly disclaimed any advice of counsel defense, stating: “Google
17 admits that it is not currently asserting an advice of counsel defense” to Oracle’s claim of willful
18 infringement. Google’s First Suppl. Resp. and Obj. to Oracle’s Requests For Admission, Set
19 Two, No. 274 at 29-30. Google made the strategic decision not to assert an advice of counsel
20 defense either because it did not have advice of counsel that would support it or because Google
21 did not want to waive the privilege associated with asserting such a defense. Whatever the
22 reason, Google cannot now claim to have relied on the advice of counsel as a way to rebut
23 Oracle’s claim of willfulness.

24 Google must have performed the same calculation in choosing not to interject a similar
25 defense based on reliance on the Court’s copyrightability decision. In order to show that Google,
26

27 ² Oracle is fully aware that the Court prepared its own Final Pretrial Conference Order which
28 does not include this agreement of the parties. *See* ECF No. 1760. Oracle’s point is simply that
the parties agreed not to get into the procedural history of the case. That was also the Court’s
view in its Tentative Trial Plan, ECF No. 1488 at 2, with regard to the prior jury verdict.

1 in fact, relied on the Court's copyrightability decision, it would almost certainly have to show that
 2 its lawyers reviewed the decision and advised the business executives at Google that they could
 3 continue to pursue new, otherwise-infringing versions of Android. This would require Google to
 4 waive its attorney-client privilege with regard to any and all analyses that its lawyers performed
 5 regarding the Court's copyrightability decision and Google's chances on appeal and in the
 6 Supreme Court as well as attorney-client and work-product materials from throughout the appeal
 7 assessing Google's chances of prevailing. Absent that evidence, it would be impossible for this
 8 Court, Oracle, or the jury to assess whether Google actually relied on this Court's decision or
 9 rather believed it might lose on appeal and chose to proceed in the face of that risk.

10 Therefore, even if Google were allowed now (well past the 12th hour) to interject such a
 11 defense, Google would be compelled to waive its privilege. This is because the mere *existence* of
 12 the Court's 2012 decision does not prove Google relied on it (which might otherwise tend to
 13 negate willfulness). It is possible that Google's counsel advised caution after the 2012 decision
 14 because Google was unlikely to prevail on appeal, which would actually tend to *support* willful-
 15 ness. Further, to give the jury the complete picture, Oracle must then be entitled to discovery or
 16 at least examine Google witnesses relating to, for example, Google's analyses of its chances of
 17 winning on appeal, before the Supreme Court, and again on remand. And if Google claimed to
 18 rely on "law in the case" dating to the time it decided to copy, then Google will have essentially
 19 waived the entire privilege, making it all fair game.

20 ***Failure to sub-divide case into different time periods.*** As discussed in Oracle's previous
 21 brief on the topic, "[t]he effect of a reversal of a judgment is to nullify it completely and to leave
 22 the case standing as if such judgment had never been rendered." ECF No. 1874 at 5 (ellipses
 23 omitted) (collecting cases and quoting *CGB Occupational Therapy, Inc. v. RHA Health Servs.,*
 24 *Inc.*, 499 F.3d 184, 188 n.2 (3d Cir. 2007)). Accordingly, ever since the case was remanded, the
 25 parties have proceeded with the fair use, willfulness, and damages case in agreement that all of
 26 the Android versions at issue rise and fall together. Google has never suggested that some
 27 Android versions may be a fair use and others not, that some Android versions may be willful
 28 infringement and others not, or that Oracle is entitled only to damages for some versions of

1 Android and not others. That is not how the case has been litigated, and it would be manifestly
 2 unfair to change the rules and the parties' understanding now—in the middle of trial.

3 Indeed, throughout the remand proceedings, both parties have consistently represented—
 4 with full knowledge of the Court's 2012 decision, the Federal Circuit's 2014 decision, and the
 5 releases of new versions of Android falling on both sides of those decisions—that there is no
 6 theory that justifies breaking up the case into different time periods. For example, in their
 7 Responses to the Court's Order Re Damages Studies, the parties each represented that the
 8 damages and fair use theories in the case did *not* require segmenting the infringement period or
 9 requiring the jury to consider different time periods. ECF No. 1364 (Oracle); ECF No. 1362
 10 (Google). The parties' proposed verdict forms also contemplate a single continuous fair use,
 11 damages, and willfulness period by asking for only one response on each, instead of dividing the
 12 case into separate time periods. *See, e.g.*, ECF Nos. 1700-1 (Oracle), 1700-2 (Google).

13 This joint treatment of infringement as continuous is also evident in the parties' arguments
 14 to the Court regarding jury instructions, none of which (a) request an instruction that separates out
 15 certain Android versions or certain periods of time with regard to fair use, willfulness or damages
 16 or (b) object to the Court's proposed fair use instruction for not separating out certain Android
 17 versions or certain periods of time. *See* ECF Nos. 1488, 1615, 1688, 1716, 1790, 1828 (Court's
 18 proposed instructions that the Android versions in play all infringe unless fair use); ECF No. 1703
 19 (Joint Proposed Jury Instructions, which do not separate out into different instructions various
 20 Android versions); ECF Nos. 1661, 1678, 1703, 1743, 1776, 1813 (Google Proposed Jury
 21 Instructions, which do not object to the Court's proposal to present the same instruction on all
 22 Android versions); ECF Nos. 1707, 1527, 1663, 1679, 1744, 1777, 1814 (same as to Oracle's
 23 Proposed Jury Instructions).

24 Because the parties have never litigated this case by separating out and individually an-
 25 alyzing fair use for each version of Android, the Court should not interject into the jury delibera-
 26 tions through an instruction the possibility that the various versions of Android should be analyz-
 27 ed differently depending on when they were released. Moreover, any instruction that contem-
 28 plates dividing the case into time periods (i.e., prior to May 2012, May 2012 to May 2014, and

June 2014 to December 2015) must indicate that there were versions of Android that came out *after* the Federal Circuit reversed, so that Oracle can present evidence that Google continued to release versions of Android containing the infringing code in willful disregard of the Federal Circuit’s decision. To present the full scope of Google’s willful infringement in that context, Oracle should be permitted to introduce evidence that Google copied not just from Java SE 1.4 and 5.0 but also from Java SE 1.6 and Java SE 1.7, which the Court previously disallowed.

II. THE COURT’S 2012 DECISION AND OTHER PRE-2014 “LAW IN THE CASE” IS IRRELEVANT TO GOOGLE’S WILLFULNESS OR BAD FAITH

Subjective willfulness standard. The standard for willfulness and bad faith in copyright cases is subjective; there is no threshold objective reasonableness component as in patent law.³ Compare *Los Angeles News Serv. v. KCAL-TV Channel 9*, 108 F.3d 1119, 1122 (9th Cir. 1997) (“‘[T]he propriety of the defendant’s conduct’ is relevant to the character of the use at least to the extent that it may knowingly have exploited a purloined work for free that could have been obtained for a fee.”); *Louis Vuitton Malletier, S.A. v. Akanoc Sols., Inc.*, 658 F.3d 936, 944 (9th Cir. 2011) (“To prove ‘willfulness’ under the Copyright Act, the plaintiff must show (1) that the defendant was actually aware of the infringing activity, or (2) that the defendant’s actions were the result of reckless disregard for, or willful blindness to, the copyright holder’s rights.”) with *Bard Peripheral Vascular, Inc. v. W.L. Gore & Assocs., Inc.*, 682 F.3d 1003, 1005 (Fed. Cir. 2012) (detailing two step willfulness inquiry in which patentee must show (1) “that the infringer acted despite an objectively high likelihood that its actions constituted infringement of a valid patent” and (2) “that this objectively-defined risk ... was either known or so obvious that it should have been known to the accused infringer.”).⁴ In this copyright case, it is for the jury to decide, with reference to actual facts that go to Google’s knowledge and intent, whether Google was

³ Google cites *Princeton Univ. Press v. Mich. Document Servs.*, 99 F.3d 1381, 1392 (6th Cir. 1996) (en banc), for the proposition that willfulness can also be an objective standard in a copyright case. ECF No. 1896. That case is inapposite for many reasons. First, that is not the law in the Ninth Circuit. Second, both parties invited use of the objective standard: The plaintiff did not assert bad faith, but instead argued the defendant’s was objectively *unreasonable*. *Id.* at 1392. Third, the defendant revealed the content of discussions with his attorney, and claimed he read case law on fair use. *Id.* at 1384. None of this is present in the instant case.

⁴ The Supreme Court is currently reviewing this standard. See *Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 136 S. Ct. 356 (2015); *Stryker Corp. v. Zimmer, Inc.*, 136 S. Ct. 356 (2015).

1 willful when it decided to copy the declaring code and SSO of the 37 Java API packages. *See*
 2 ECF No. 1803 at 1 (Court’s Order on Expert Testimony) (“The mental state of the characters in
 3 our story on trial is for the jury to decide, never for experts to speculate about.”). Google has not
 4 asserted that it relied on advice of counsel or the Court’s decision, and thus the state of the law at
 5 the time Google acted is irrelevant in this case.⁵

6 ***Courts have found willfulness on remand.*** In both copyright and patent cases, trial
 7 courts have found willfulness on remand even after an initial decision for the defendant was
 8 reversed on appeal. *See, e.g., Situation Mgmt. Sys., Inc. v. Lamoco Consulting, LLC*, No. 06-
 9 11557-RGS, 2011 WL 1226114, at *5 (D. Mass. Mar. 30, 2011) (finding willful copyright
 10 infringement on remand even after the defendant first prevailed in district court only to lose on
 11 appeal), *on remand from Situation Mgmt. Sys., Inc. v. ASP. Consulting LLC*, 560 F.3d 53, 57, 60-
 12 61, 62 (1st Cir. 2009). And in the patent context, where the state of the law can be relevant to the
 13 objective prong of willfulness, there are *numerous* cases in which the defendant’s infringement
 14 was found to be willful on remand even where, as in this case, the defendant first prevailed in the
 15 district court, only to lose on appeal. *See, e.g., Liquid Dynamics Corp. v. Vaughan Co., Inc.*, No.
 16 CIV.A. 01 C 6934, 2008 WL 4643428, at *1 (N.D. Ill. Oct. 20, 2008), *on remand from* 355 F.3d
 17 1361, 1362-63 (Fed. Cir. 2004) (2-1 decision); *Odetics, Inc. v. Storage Tech. Corp.*, 14 F. Supp.
 18 2d 800, 801-02 (E.D. Va. 1998) (erroneous claim construction), *on remand from* 116 F.3d 1497,
 19 1507 (Fed. Cir. 1997), *aff’d* 185 F.3d 1259 (Fed. Cir. 1999); *Jenn-Air Corp. v. Penn Ventilator*
 20 *Co.*, 394 F. Supp. 665, 667, 676-77 (E.D. Pa. 1975), *on remand from* 464 F.2d 48, 49 (3d Cir.
 21 1972). These willfulness findings on remand are particularly striking given that the objective
 22 prong of willfulness in patent cases must be proved by *clear and convincing* evidence. *See Bard*
 23 *Peripheral*, 682 F.3d at 1005. In fact, the trial court on remand in *AIA Engineering Ltd. v.*
 24 *Magotteaux International S/A*, No. 3:09-CV-00255, 2012 WL 4442665, at *1-2, *6-7 (M.D.
 25 Tenn. Sept. 21, 2012), *aff’d* 530 F. App’x 959 (Fed. Cir. 2013), specifically stated the defendant
 26 could be objectively willful—despite the court’s own prior invalidity decision—given the

27 _____
 28 ⁵ This may be different if Google had offered an “advice of counsel” defense, but, as discussed
 above, Google disclaimed any such defense and never disclosed reliance on this Court’s 2012
 decision or any other case law.

evidence at trial. *See also Advanced Display Sys., Inc. v. Kent State Univ.*, No. 3-96-CV-1480-BD, 2002 WL 1489555, at *1-2, 8 (N.D. Tex. July 10, 2002) (same).

There are patent cases in which willfulness was not found on remand. However in each of these cases the trial court based its decision on the advice of counsel defense or on the *objective* prong—not once did a court inform the jury of the case’s procedural history so the jury could determine whether it believed the defendant’s infringement was willful based on the state of the law or the district court’s earlier decision. *See, e.g., Solvay, S.A. v. Honeywell Specialty Materials LLC*, 827 F. Supp. 2d 358, 365-66 (D. Del. 2011); *Uniloc USA, Inc. v. Microsoft Corp.*, 640 F. Supp. 2d 150, 177 (D.R.I. 2009) (objective prong), *aff’d in part, rev’d in part*, 632 F.3d 1292 (Fed. Cir. 2011); *Honeywell Int’l Inc. v. Universal Avionics Sys. Corp.*, 585 F. Supp. 2d 636, 643-44 (D. Del. 2008); *Franklin Elec. Co. v. Dover Corp.*, No. 05-C-598-S, 2007 WL 5067678, at *8 (W.D. Wis. Nov. 15, 2007); *see also Universal Athletic Sales Co. v. Am. Gym*, 480 F. Supp. 408, 414 (W.D. Pa. 1979) (advice of counsel).⁶

Google’s reliance on Kamar is misplaced. Google asserts, incorrectly, that *Kamar International, Inc. v. Russ Berrie and Co., Inc.*, 752 F.2d 1326, 1329 (9th Cir. 1984), stands for the proposition that Google cannot have acted willfully or in bad faith between this Court’s 2012 copyrightability decision and the Federal Circuit’s decision. ECF No. 1884 at 3-4. The *Kamar* language Google relies on has nothing whatever to do with willfulness or bad faith. In fact, in *Kamar*, the trial court’s erroneous copyrightability decision *did not* factor into the Ninth Circuit’s willfulness analysis at all.

The *Kamar* language Google seizes upon has to do with whether a defendant has “notice” of infringement—a term of art under the 1909 Copyright Act—after a favorable trial court ruling. The 1909 Act imposed a certain cap on statutory damages unless the infringement took place *after* the defendant received notice of infringement allegations, such as through service of process or other written notice. *Id.* at 1329. The defendant in *Kamar* did not actually copy the plaintiff’s

⁶ Oracle could identify only one unfavorable copyright case on this issue. In *Jarvis v. K2 Inc.*, No. C03-1265Z, 2008 WL 630008, at *6 n.6 (W.D. Wash. Mar. 5, 2008), the court noted in dicta in a footnote (on remand after a bench trial) that, “in light of the divergent rulings in this case,” the court would not have found willfulness. *Jarvis* is not about a jury instruction and does not support that the jury should learn of divergent rulings in the case.

1 work, as Google did here; rather, the defendant sold stuffed animals that it purchased from
 2 Korean manufacturers “who claimed them as original designs.” *Id.* at 1328. This fact, combined
 3 with the notice provision, caused the court to separate damages into three groups: pre-notice
 4 sales (sales before the lawsuit), post-notice sales (sales after the lawsuit), and sales occurring after
 5 the district court erroneously held that the toys were neither infringing nor copyrightable. *Id.* at
 6 1329-31. The court found that the defendant’s infringement after the district court’s decision did
 7 “not count as infringement *after notice*” because the defendant “was entitled to rely on the
 8 judgment at that time.” *Id.* at 1330 (emphasis added).

9 This conclusion about notice under the old Copyright Act does not help Google’s willful-
 10 ness argument: *Kamar* itself held that notice is not the same thing as willfulness, and it analyzed
 11 the two issues separately.⁷ *Id.* at 1331. Further, the court affirmed the district court’s finding of
 12 no willfulness, even as to the period of time the defendant had notice after the filing of the
 13 complaint, because the defendant in *Kamar* completely changed its behavior thereafter (it only
 14 *inadvertently* sold a few toys after the start of the suit). *Id.* As to the period of time after the trial
 15 court’s erroneous decision, the court made no specific finding on willfulness; in fact, the trial
 16 court’s erroneous decision *did not* factor into the court’s willfulness analysis at all. *Id.* Google,
 17 by contrast, *intentionally copied* Oracle’s IP and continues to *deliberately* sell products containing
 18 the 37 Java API packages long after it knew that Sun and then Oracle objected. *Kamar* does not
 19 protect Google from a willfulness finding. Finally, *Kamar* involved a bench trial; no jury was
 20 ever instructed about the district court’s earlier decision or the court of appeals’ reversal.

21 ***The law was clear.*** Respectfully, Oracle submits that Google could not have relied on
 22 advice of counsel because the law was clear well before 2012 that works such as the declaring
 23 code and structure, sequence, and organization of software packages were copyright protected.
 24 The Federal Circuit broke no new ground in reaching its decision.

25
 26
 27 ⁷ *Princeton Univ. Press*, 99 F.3d at 1392, a case Google relies on heavily in its recent brief on this
 28 issue, ECF No. 1896, also makes clear that willfulness is different from notice: “Continued use of
 a work even after one has been notified of his or her alleged infringement does not constitute
 willfulness so long as one believes reasonably, and in good faith, that he or she is not infringing.”

1 It has been beyond dispute that computer programs are copyrightable since Congress
2 added “computer program[s]” to 17 U.S.C. § 101 through the Computer Software Copyright Act
3 of 1980, 94 Stat. 3015, enacted to implement the National Commission on New Technological
4 Uses of Copyrighted Works (“CONTU”) study. As to the declaring code, there was never any
5 dispute that it was “creative and original.” *Oracle Am., Inc. v. Google Inc.*, 750 F.3d 1339, 1365
6 (Fed. Cir. 2014). The question then was simply one of merger: whether the creative expression
7 of the declaring code merged with the idea of the code itself. Based on this Court’s factual
8 findings that “nothing prevented Google from writing its own declaring code ... to achieve the
9 same result,” the Federal Circuit relied on precedents from the 1980s, 1990s, and early 2000s to
10 hold that the expression in the declaring code did not merge because the Oracle developers had so
11 many options available to them when they were writing the code. *Id.* at 359-62 (collecting cases).

12 As to the structure, sequence, and organization, the Federal Circuit applied a similar
13 analysis to conclude that the SSO was “original and creative,” *id.* at 1363, and that the SSO was
14 not a method of operation because the expression of the SSO did not merge with its idea and
15 function, *id.* at 1365-68 (collecting cases). In reaching that conclusion, the Federal Circuit relied
16 on the definition of computer program in the Copyright Act, the legislative history of the
17 Copyright Act, the CONTU Report, and decisions regarding copyright protection for the SSO of
18 computer programs from the 1980s.

19 Finally, the Federal Circuit held that *Sega v. Accolade* and *Sony v. Connectix* were
20 completely inapposite because those cases were fair use cases irrelevant to the threshold question
21 of copyrightability. *Oracle Am.*, 750 F.3d at 1368-72.

22 While the precise question of copyright protection for APIs might not have been litigated,
23 courts had long held that source code and the SSO of computer programs are copyrightable.
24 From there, questions of merger, scenes a faire, short phrases, and method of operation were all
25 governed by traditional modes of copyright analysis that had been well-settled for decades.
26 Despite this Court’s copyrightability decision, Oracle respectfully submits that it was not unclear
27 under prevailing copyright law whether the declaring code and SSO of the 37 Java API packages
28 were copyright protected.

III. ORACLE HAS NOT OPENED THE DOOR TO THE COURT PROVIDING THE CONTEMPLATED INSTRUCTION

The parties' agreement that the procedural history of the case is off limits can only be overridden if "either party opens the door to such evidence or argument, and [only] after prior clearance with the Court." ECF No. 1709 (Joint [Proposed] Final Pretrial Order) at 7. Neither party has opened the door by discussing the procedural history of this case in front of the jury, and Google does not argue that the door has been opened. And as the Court has already informed the parties, the Court is of the view (contrary to Google's position) that an instruction is not yet required. Trial Tr. 935:24-936:4.

Google instead asserts it is unfairly prejudiced by statements relating to Google's continued release of new versions of Android even though Google knew better. *See* ECF No. 1884 at 1-2. Google first complains that Oracle's opening stated that "Google kept coming out with new what they call flavors" and that the "[n]ew versions of Android, each time using these APIs, even though they knew that they shouldn't be doing that. Gingerbread, Honeycomb, Ice Cream Sandwich, Jelly Bean." Trial Tr. 277:1-5. Such statements do not unfairly prejudice Google. It is undisputed that each of those versions (Gingerbread, Honeycomb, Ice Cream Sandwich, Jelly Bean, and others) contains Oracle's copyrighted works. Indeed, the Court has already so instructed the jury. There is nothing prejudicial about Oracle stating that each version of Android at issue contains infringing material and thus is infringing unless Google proves fair use.

The same goes for the only other type of statement about which Google complains. During the cross examination of Google's Eric Schmidt, Oracle's counsel asked: "Q: And did you take any steps, after this lawsuit got filed in August 2010, to take out of the mobile devices on the market any code or anything relating to those API packages? A: I'm not aware of any in that time period." *See* ECF No. 1884 (Google Br.) at 2 (quoting Trial Tr. 394:15-18). This exchange is not prejudicial at all, as the question and answer focus on (1) the time period immediately after this suit was filed in August 2010, long before this Court's copyrightability decision, and (2) the devices *on the market* at the time.

1 **IV. EVEN IF PRE-2014 “LAW IN THE CASE” WERE RELEVANT, THIS IS AN**
 2 **ISSUE FOR THE COURT TO DECIDE, NOT THE JURY**

3 Even if the Court’s 2012 decision or any other “law in the case” were relevant to Google’s
 4 willfulness and bad faith, the issue would be one for the Court to decide, not the jury. As detailed
 5 above, Oracle is not aware of a court *ever* instructing the jury in the manner of the Court’s pro-
 6 posed instruction. Google asserts that, in light of *Kamar*, a court instruction about the 2012 copy-
 7 rightability decision is warranted, citing in support *Waco International, Inc. v. KHK Scaffolding*
 8 *Houston Inc.*, 278 F.3d 523 (5th Cir. 2002). ECF No. 1884 at 3-4. But *Kamar* has no application
 9 here, as the case involved a bench trial and says nothing about instructing a jury. *Waco Interna-*
 10 *tional* is similarly inapposite. There, the trial court mentioned certain facets of the procedural
 11 history of the case to the entire *venire*—not the petit jury—during *voir dire*. *Waco Int’l*, 278 F.3d
 12 at 528. This procedural history involved an *ex parte* seizure that was highly probative to a claim
 13 the jury had to decide: whether the plaintiff had acted in bad faith by obtaining an *ex parte*
 14 seizure order against the defendant. *Id.* at 529. While the trial court revealed more than it needed
 15 to, the Fifth Circuit concluded the trial court did not err because the procedural statements were
 16 *made during voir dire* and because the plaintiff did *not object* to these statements or ask for
 17 clarification. *Id.* at 529-30.

18 Here, as Oracle explained in its earlier brief on the topic, if the Court instructs the jury as
 19 to its 2012 copyrightability decision, it would result in a mistrial. *See* ECF No. 1874 at 1-2. The
 20 Court’s instruction would interject the Court as a fact witness into the trial, which is prohibited
 21 under Federal Rule of Evidence 605. The proposed instruction stating that the Court originally
 22 held the API packages were not copyrightable would likely lead the jury to conclude erroneously
 23 that Google’s use must have been fair. That is not the law, and it would be tremendously prejudi-
 24 cial to Oracle. Indeed, the Court need look no further than Google’s exuberant support of an
 25 instruction on this topic to know that the result of the instruction is entirely one-sided.

26 Moreover, it is blackletter law that legal questions are for the court and factual questions
 27 are for the jury. Asking the jury to determine “legal facts,” such as whether the law was
 28 sufficiently unclear that Google acted reasonably, is not a question that the jury is institutionally

capable of answering. *Cf. Elder v. Holloway*, 510 U.S. 510, 516 (1994) (rejecting the concept of “legal facts” about the state of the law in the context of qualified immunity and holding that the state of the law is a “question of law, not one of ‘legal facts’”). That is why in patent cases the objective prong of willfulness is for the court to decide and the subjective prong is generally for the jury to decide. *See Bard*, 682 F.3d at 1006-08. The alternative is chaos, where the parties argue case authority to the jury in an attempt to persuade the jury of what the law was at the relevant time. It certainly would not be permissible for Oracle to submit to the jury as evidence of willfulness the case law that Oracle contends showed at every point in time from when Google chose to copy until the Federal Circuit’s decision in 2014 that Google’s copying was clearly an infringement. It should not be permissible for the Court to do the same through an instruction about its previous decision in the case or, as Google proposes, an explicit statement that the law was “unclear” or “unsettled” at points throughout the litigation.

The standard in copyright cases is reckless disregard or willful blindness to a copyright holder’s rights. *Supra* 6. Though not identical, the copyright standard is perhaps somewhat analogous to the subjective prong in patent cases, which is entirely left to the jury. The jury is never instructed on legal matters, like the state of the law, in assessing willfulness under the subjective prong. Nevertheless, if the Court believes that Google could not have willfully infringed as to certain versions of Android *as a matter of law based on the law at the time*, the Court may be able to render such a decision (after full briefing) after the jury renders its verdict in Phase II, where willfulness will be at issue and Oracle will have an opportunity to present its entire case on willfulness.⁸

In any event, regardless of the Court’s views on that issue, the jury cannot be asked to decide whether the law was sufficiently clear when Google chose to copy. Because the state of the law at the time is not a matter for the jury, providing such an instruction only risks improperly turning the Court into a fact witness, unnecessarily confusing the jury, and irreparably prejudicing Oracle to the point of requiring a mistrial and a third trial in this matter.

⁸ Oracle cautions, however, that the Federal Circuit’s decision quite strongly demonstrates through its reliance on traditional copyright principles that the law was clear that the declaring code and SSO were copyrightable before 2012. *Supra* 9-10.

CONCLUSION

For the foregoing reasons, the Court should not instruct the jury as to this case's procedural history.

Dated: May 16, 2016

Respectfully submitted,

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